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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,838	03/19/2001	Duane D. Miller	20609/181 (PD 98076)	9221

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/30/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

DATE MAILED:

U.S. GPO: 1996-404-496/40517

DETAILED ACTION

Claims 1-34 are pending in the application.

Election/Restrictions

Applicants' election with traverse of Group I, claims 1, 3-7 and 12, and the species of Compound 56a in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the claims of the present application are closely related and, therefore, require common areas of search and consideration. Applicants state that there are a number of groups set forth in the restriction requirement that cannot exist.

Applicants' arguments have been considered but have not been found persuasive. Section 121 provides the Commissioner of Patents and Trademarks with the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. In the instant application, the Examiner has determined that several independent and distinct inventions are claimed in the application. Each of the groups set forth in the restriction require separate search considerations and therefore, it would impose an undue

burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

Further, Applicants state that a group, such as Group III, cannot exist. In response, claim 1 states that "at least one of X^1 , X^2 , and X^3 is $(HO)_2PO-Z^1$ -" (page 92, lines 6-8). This conveys to one skilled in the art that one, two or all three of X^1 , X^2 and X^3 can represent $(HO)_2PO-Z^1$ -. An "and" is not used after this first definition of X^1 , X^2 and X^3 . Therefore, the interpretation is that the first definition of X^1 , X^2 and X^3 is not read in conjunction with the second definition of X^1 , X^2 and X^3 (page 92, lines 9-11). Hence, Group III can exist.

The requirement is still deemed proper and is therefore made
FINAL.

The generic concept which has been examined, inclusive of the elected species of Compound 56a, is as follows:

One of X^1 and X^2 is $-Z^1-OP(OH)_2$ and the other is R^1-Y^1-A ;

X^3 is R^1-Y^1-A ;

Z^1 is $-O-$ or $-O(CH_2)_m$ wherein m is 1 to 50;

A is a direct link

Y^1 is NR^2 ; and

R^1 is H, alkyl, alkenyl or acyl.

The generic concept is embraced by claims 1, 3-7 and 12.

The Information Disclosure Statements filed on September 20, 2001 {Paper No. 4} and October 2, 2002 {Paper No. 10} have been considered to the extent of the examined generic concept.

Subject matter not embraced by the above identified generic concept and claims 2, 8-11 and 13-34 are withdrawn from further

consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences

in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 recites the broad recitation "acyl", and the claim also recites "including a C1 to C30 alkyl" which is the narrower statement of the range/limitation. Also note the use of "including" in the definition of R².

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- a) Noort et al. {Bioorganic & Medicinal Chemistry Letters (August 20, 1996), 6(16), pages 2007-2012} – see Compound 2 on page 2008 (or CA Registry No. 90013-43-7);
- b) Avaeva et al. {CA 73:31861, 1970} – see CA Registry No. 18942-69-3; and
- c) Avaeva et al. {CA 76:34548, 1972} – see CA Registry Nos. 14406-99-6 and 34965-63-4.

Each of the above cited prior art references disclose products embraced by the instant invention.

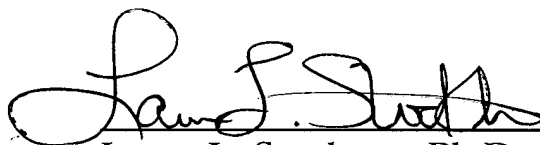
Allowable Subject Matter

The elected species of Compound 56a is allowable over the art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read 'Laura L. Stockton', written over a horizontal line.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

October 29, 2002